

III. REMARKS/ARGUMENTS

A. Status of the Claims

Claims 1-3, 5-19, 27-29 and 31-41 are pending. Claims 4, 20-26, 30, and 42-46 have been previously cancelled. Claims 1, 2, 5, 6, 14, 27, 28, 31, 32, and 36 have been amended. No new matter is introduced by these amendments, and these amendments are fully supported by the specification. Applicants respectfully request reconsideration of the rejections of these claims for at least the following reasons.

B. Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1, 2, 5-14, 19, 27, 28, 31-36 and 41 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,185,697 to Jacobs *et al.* (“Jacobs”). Specifically, the Office Action contends that Jacobs discloses all elements of these claims. Applicants respectfully disagree.

In order for a claim to be anticipated by a reference, that reference must disclose each and every element of the claimed invention. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”); *see also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (“The identical invention must be shown in as complete detail as is contained in the ... claim.”).

Independent claim 1 recites:

1. A method for providing business continuity in an enterprise comprising:

collecting resource information, the resource information describing at least one resource used by the enterprise, *wherein the at least one resource is a department within the enterprise;*

storing in a database resource information describing the at least one resource;

assessing a criticality of the at least one resource;

storing the assessment of the criticality of the at least one resource in the database;

developing a recovery plan for recovery from a loss of use of the at least one resource, wherein the recovery plan aims to ensure the business continuity of the at least one resource;

storing the recovery plan in the database;

assessing the recovery plan;

storing the assessment of the recovery plan in the database;

testing the recovery plan and recording the results of the testing;

storing the recorded results of the testing in the database; and

providing status data from the database, wherein the status data comprises at least one of a status of:

the collection of the resource data;

the assessment of the criticality;

the development of the recovery plan; and

the testing of the recovery plan.

Appl'n, Claim 1 (emphasis added). As is clear from the emphasized text, the pending claims are directed to a method for providing *business continuity in an enterprise, wherein the at least one resource is a department within the enterprise.*¹

Jacobs is not concerned with providing business continuity for a department within the enterprise. Instead, Jacobs is directed to a “*crisis management system*” for receiving information from various sources, chronologically organizing the

¹ Independent claim 27 similarly recites that “the at least one resource is a department within the enterprise.”

information in files, updating automatically all related files, and providing the information in a comprehensive format to assist authorities during a crisis.”

Jacobs, Col. 1, ll. 9-13(emphasis added). As examples of crises, Jacobs discloses hijackings, kidnapping, and earthquakes. *See* Jacobs at Col. 5, ll. 10-13 (“Thus, when a hijacking or kidnapping crisis situation is confirmed, or when a earthquake crisis situation is realized, crisis management commences.”). Jacobs discloses collecting Notably, these crises may be completely disconnected with the resource.

The Office Action asserts, in rejecting claim 1, that Jacobs is concerned with maintaining business continuity for “topic files in central computer store 114.” Office Action, page 3. This is incorrect. Although these files may be updated during a crisis, Jacobs does not disclose that these files are the object of the crisis. Further, in rejecting several dependent claims, including dependent claim 2, the Office Action next asserts that the resource is “a department within the enterprise (*i.e.*, FAA, CIA and FBI within the government).....” Office Action, Page 4. Although Jacobs mentions these agencies in its Background section (specifically, as examples of agencies that face crises), it also does not disclose maintaining business continuity for these agencies.

Therefore, Jacobs fails to disclose all elements of independent claim 1 and independent claim 27. Applicants respectfully request that the rejection of independent claims 1 and 27, and all claims dependent thereon, be withdrawn.

C. Claim Rejections Under 35 U.S.C. § 103(a)

1. Claims 3, 17, and 19, 29, 39 and 40

Claims 3, 17, 19, 29, 39 and 40 stand rejected as allegedly rendered obvious by Jacobs in view of U.S. Patent Publication No. 2004/0103431 to Davenport *et al.*

² Applicants note, however, that claims 3, 17, and 19, and claims 29, 39 and 40 are

² Applicants’ representative contacted the Examiner to confirm that this

dependent on independent claims 1 and 27, respectively, and are allowable for at least the reasons set for the above. *See* MPEP 2143.03 (“If an independent claim is nonobvious under 35 U.S.C 103, then any claim depending therefrom is nonobvious.”) (quoting *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Therefore, Applicant respectfully requests that the rejections of claims 3, 17, and 19, 29, 39 and 40 be withdrawn.

2. Claims 15, 16, 37 and 38

Claims 15, 16, 37 and 38 stand rejected as allegedly rendered obvious by Jacobs. Specifically, with regard to claims 15 and 16, after apparently admitting that Jacobs does not disclose “generating a wallet card for the employee using the employee resource information, wherein the wallet card is generated at a workstation of the employee, and the wallet card contains a hotline, a website, and at least one emergency location that the employee can use in an emergency,” the Office Action asserts that “wallet cards are old and well known. Office Action, page 11. Thus, the Office Action contends that

[i]t would have been obvious to one of ordinary skill in the art to include a wallet card in the Jacobs et al system, since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable

Id. The Office Action rejects claims 37 and 38 based on the “same rationale.” *Id.* Applicants respectfully disagree.

At the outset, it is unclear as to whether or not the Office Notice of the “generating a wallet card for the employee using the employee resource information.” *Id.* at page 11. “Official notice unsupported by documentary

rejection is based on the Jacobs patent, not a Jacobs patent application.

evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” MPEP 2144.03(A). If the Office Action is taking Official Notice, “[t]he examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” MPEP 2144.03(B) (emphasis added). Further, “[t]he applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice so as to adequately traverse the rejection in the next reply after the Office Action in which the common knowledge statement was made.” *Id.* If the Office Action is, in fact, taking Official Notice of this element, Applicants respectfully traverse such Official Notice, and respectfully request the Examiner to provide the requisite “specific factual findings” and “explicit basis” for those findings, and further requests the Examiner to produce a reference disclosing the claimed feature. MPEP 2144.03(C) (“If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained.”).

Regardless, claims 15, 16 and claims 37 and 38 dependent on independent claims 1 and 27, respectively, and are allowable for at least the reasons set for the above. *See* MPEP 2143.03 (“If an independent claim is nonobvious under 35 U.S.C 103, then any claim depending therefrom is nonobvious.”) (quoting *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Therefore, Applicant respectfully requests that the rejections of claims 15, 16, 38 and 39 be withdrawn.

IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is

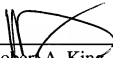
courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

Dated: July 16, 2009

By:


Robert A. King
Registration No. 42,738

HUNTON & WILLIAMS LLP
1900 K Street, N.W.
Suite 1200
Washington, D.C. 20006-1109
Telephone: 202.955.1500
Facsimile: 202.778.2201